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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,698

11/21/2003

Olivier Pinto

979-042

1348

7590 03/14/2007  
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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,698	<b>Applicant(s)</b> PINTO, OLIVIER	
	<b>Examiner</b> Jill M. Gray	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). .
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Amendment after Final filed February 12, 2007 has been entered. The finality of the last Office Action has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakurau et al, 6,770,820 B2 (Sakurai).

Sakurai teaches a cable comprising a transmission element, a flammable element, and a flame-retardant coating of a cross-linkable resin surrounding the flammable element and comprising phosphoric acid methacrylate. See for example column 1, lines 24-33 and lines 58-61. Claim 8 is a product-by-process claim wherein process limitations add no patentable weight to the flame-retardant coating layer.

Therefore, the teachings of Sakurai anticipate the invention as claimed in present claims 1-8.

3. Claims 1-8, 10-11, 13-14, 16, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chase et al, US 2005/0089290 A1 (Chase).

Chase teaches a flame-retardant cable essentially as claimed by applicant comprising a transmission element, a flammable element, and a flame-retardant coating layer of cross-linkable resin surrounding said flammable element, wherein said flame-retardant layer is of the type contemplated by applicant and comprises a polymerizable composition that includes at least one phosphorus group such that the phosphorus group is chemically bonded to said polymer, as required by claims 1-4 and said transmission element is a conductor of light having a flammable insulating layer, per claims 5-7. See abstract, page 1, [0002]; page 2, [0022] and [0023], and page 3, [0027]. In addition, Chase teaches that his composition contains a reactive diluent of the type contemplated by applicants, whereby said diluent is present within the instant claimed ranges, as required by claims 10-11, 16 and 20. See page 4 [0044]-[0046]. The composition is polymerizable by actinic radiation as required by claim 13, and the amount of photoinitiator is within the present claimed range required by claims 14 and

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18. See page 4 [0044] and page 6 [0062]. Claim 8 is a product-by-process claim wherein process limitations add no patentable weight to the flam-retardant coating layer.

Therefore, the teachings of Chase anticipate the invention as claimed in present claims 1-8, 10-11, 13- 14, 16, 18, and 20.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 12, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al, US 2005/0089290 A1 (Chase) as applied above to claims 1-8, 10-11, 13- 14, 16, 18, and 20.

Chase is as set forth above but does not specifically teach the acrylate equivalent weight. In this regard, it is the examiner's position that the compound of Chase is substantially similar to that contemplated by applicants and thus the examiner has reason to believe that properties such as acrylate equivalent weight are the same as well, in the absence of factual evidence to the contrary. Regarding claim 15, Chase teaches that various acrylates can be used in his composition with a reasonable expectation of success. Accordingly, in the absence of unexpected or superior properties of the resultant flame-retardant cable, said properties being directly related to the presence of the specific acrylate, this limitation is not construed to be a matter of

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invention. Regarding the amounts of each component, it is the examiner's position that since the results sought and the ingredients used were known, it was within the expected skills of one having ordinary skill in this art to arrive at the optimum proportion of those ingredients. *In re Reese*, 129 USPQ 402 (CCPA 1961).

1. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al, 6,755,995 B1 (Hasegawa) in view of Hall 6,025,422, further in view of Ogawa et al, 4,417,018 (Ogawa), for reasons of record.

***Response to Arguments***

2. Applicant's arguments and Declaration filed February 12, 2007 have been fully considered but they are not persuasive.

More specifically, phosphorus compounds are known flame retardants and said known compounds embrace polymeric materials having phosphorus compounds "chemically bonded" thereto as well as polymeric materials having said compounds dispersed therein. While applicants argue that the polymer of the instant invention contains phosphorus functional groups, it is not evident that the resultant flame retardant cable distinguishes over prior art flame retardant cables containing phosphorus functional groups as a flame retardant. It is not evident on this record that unexpected or superior properties result and that said properties are directly related to the phosphorus groups being "chemically bonded" to said polymer.

Applicants have not clearly distinguished that which they regard as their invention.

***Claim Rejections - 35 USC § 112***

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 2 appears to contain duplicate subject matter of claim 1.

Claim 4 is indefinite because "said material" lacks the proper antecedent basis. It is not clear what material is being referred to.

Claim 16 is indefinite because the parts by weight of the antiabrasion compound are in the range of 10 to 30, whereas claim 11 establishes the amount as being less than 95. Accordingly, the metes and bounds for which patent protection is being sought are not clear.

No claims are allowed.

### ***Conclusion***

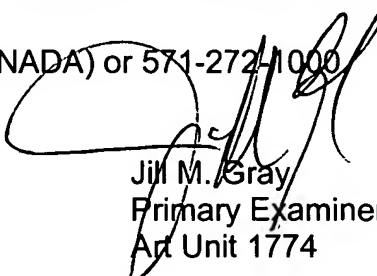
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jill M. Gray  
Primary Examiner  
Art Unit 1774

jmg